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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,541	01/05/2001	Anthony R. Rothschild	733755-6	5271
23879	7590	08/18/2008	EXAMINER	
O'Melveny & Myers LLP			CARLSON, JEFFREY D	
IP&T Calendar Department LA-1118				
400 South Hope Street			ART UNIT	PAPER NUMBER
Los Angeles, CA 90071-2899			3622	
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			08/18/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/755,541	ROTHSCHILD, ANTHONY R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 4/21/08, 5/29/08.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 62,64,65,68-70,72-77 and 79-95 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 62,64,65,68-70,72-77 and 79-95 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Rule 131 Affidavit***

1. The evidence as a whole appears sufficient to overcome the previous rejection relying on the Stanbach reference. Applicant is reminded any amendment that adds a limitation to any of the claims (including dependent claims) unsupported by the conception evidence will again make the Stanbach reference available to apply as prior art.

### ***Claim Objections***

2. Claims 72, 82, 91 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. These claims require that the electronic communication is an email message, yet each independent claim already sets forth such a limitation. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**4. Claims 62,64,65,68, 69,72, 74-77 and 79-95 are rejected under 35**

**U.S.C. 102(e) as being anticipated by Gabbard et al (US6205432).**

5. Regarding claims 62, 65, 68, 69, 72, 75-77, 81, 82, 87, 92, Gabbard et al teaches a system whereby advertising is selectively inserted into (Internet, i.e. WAN) emails sent by senders to recipients [abstract]. Gabbard et al teaches that the emails may be sent using “web mail” and that the ads are inserted before being delivered to the identified recipients [col 2: lines 19-23, 4:33, 10:8]. This arrangement of web mail is taken to provide the web server including an advertising application that permits communication data to be submitted that includes the message and the recipient email address.

Gabbard et al teaches that the ads may be automatically selected and inserted according to user demographics [abstract] which provides a teaching that there are a plurality of stored ads to choose from. Gabbard et al teaches that an implementation of the invention may include a web-based “free” email service [10:8] which is taken to provide compensation to the users of the free email service, whether they be senders benefiting from the advertising subsidization or receivers benefiting from the advertising subsidization, especially where both sender and receiver have registered as part of the free web-based email service.

6. Regarding claims 64, 74, 79, 80, 83-86, 89-91, 94, 95, Gabbard et al teaches that the advertising can be targeted based on demographics or message content [16:53-55]. The choice to select a certain ad and the insertion of that ad into an email is taken to provide “creation” of a customized ad.

7. Regarding claims 88, 93, the sender of Gabbard et al is able to specify his recipient and the message content. Gabbard et al's selection of particular ads targeted to the recipient and/or the message content as disclosed therefore can be taken to provide the feature of allowing the sender to specify ad-type data that is used to select the advertisement. Further, providing the user profile data (such as demographic information) by the user to the system is taken to address the limitation of providing advertisement-type data, as this profile information is the basis for the type of ad selected according to that user-provided information.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9. Claims 62,64,65,68-70,72-77 and 79-95 rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al.**

10. Regarding claims 62,64,65,68-70,72-77 and 79-95 Gabbard et al teaches targeting the advertisement to recipients. It would have been obvious to one of ordinary skill at the time of the invention to have alternatively, or in addition, used to the known information about the sender in order to select a targeted advertisement. This would enable emails to include relevant advertising in the case where a sender chooses to send an email to a recipient for which no profile details are known, but where the

recipient is assumed to have similar likes/lifestyles as the sender such as within the sender's circle of friends. Providing an ad with a sender's email would provide a "viral" email advertisement that has the power of implied endorsement from the sender as is generally known with free, advertising-supported/solicited email such as the Hotmail™ [2:20] service referenced by applicant and Gabbard et al. Doing so would also be taken to be compensating the sender of the email for the included advertising.

11. Regarding claims 70, 73 specifically, Gabbard et al does not explicitly state that the advertisement can be clicked, however Official Notice is taken that Internet ads are well known to include a link to further information about the advertised product and it would have been obvious to one of ordinary skill at the time of the invention to have enabled the ability for an interested user to request and receive more information about an advertised product. It would have been obvious to one of ordinary skill at the time of the invention to have hosted the ad content and/or the additional ad content on any server that can be accessed via the Internet as a mere design choice. Doing so provides a step receiving the additional ad data at the particular server before sending it to the requesting user.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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